

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) GB920030048US1	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>06-07-07</u> Signature <u>/Louise Fay/</u> Typed or printed name <u>Louise Fay</u></p>		Application Number 10798920	Filed 2004-03-11
		First Named Inventor Chessell et al.	
		Art Unit 2163	Examiner Lie, Angela M.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. <u>48,504</u> Registration number _____</p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div style="width: 50%; text-align: center;"><p><u>/Theodore D. Fay III/ TIF,</u> _____ Signature Theodore D. Fay III _____ Typed or printed name 972-385-8777 _____ Telephone number June 7, 2007 _____ Date</p></div></div> <p><small>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</small></p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Chessell et al.	§	Group Art Unit: 2163
	§	
Serial No.: 10/798,920	§	Examiner: Lie, Angela M.
	§	
Filed: March 11, 2004	§	Attorney Docket No.: GB920030048US1
	§	
For: Profiling Data in a Data Store	§	

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Respectfully submitted,

/Theodore D. Fay, III/ T.D.F.
Theodore D. Fay, III
Registration No. 48,504

Duke W. Yee
Registration No. 34,285
YEE & ASSOCIATES, P.C.
P.O. Box 802333
Dallas, Texas 75380
(972) 385-8777
ATTORNEYS FOR APPLICANTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Chessell et al.	§	
	§	
Serial No.: 10/798,920	§	Group Art Unit: 2163
	§	
Filed: March 11, 2004	§	Examiner: Lie, Angela M.
	§	
For: Profiling Data in a Data Store	§	Attorney Docket No.: GB920030048US1
	§	
	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

**REASONS IN SUPPORT OF APPELLANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Appellants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to Deposit Account No. 09-0447.

REMARKS

Appellants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed March 7, 2007. The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005. The Request is needed as the rejections are clearly erroneous.

I. Response to Claim Objection

The Examiner objects to claims 1 and 17 on the basis that the term, "determination that the intersection of the selected set and the profile set is empty," is improper because the Examiner asserts that no result exists if the intersection is empty. However, the objection is clearly erroneous because the claim goes on to state that the method provides an indication that the data store does not include data items in the selected set. Therefore, a positive result exists, that the intersection is empty, and that a positive action is taken in response to this result, which is to provide the claimed indication.

Additionally, changing the claimed term from "empty" to "exist" would change the meaning of the claim. In mathematics, the number zero exists in the set of real numbers. Thus, if the claimed intersection is empty, the intersection exists, even if empty. If the intersection is claimed as "not existing," then no intersection exists at all in the first place. In this case, the claim would be rendered indefinite and incorrect because the claim would contradict itself. In particular, the claim would recite the existence of the intersection, and in the very next phrase state that the intersection does not exist. This result is erroneous. Therefore, the objection is clearly erroneous should be withdrawn.

II. Response to Anticipation Rejection

The Examiner rejected claims 1, 17, 33, and 49 under 35 U.S.C. § 102(e) as anticipated by *Seifert*, Automated Resource Management System, U.S. Patent Application Publication 2002/0194179 (December 19, 2002) (hereinafter "*Seifert*"). This rejection is clearly in error. The Examiner states that:

As to claims 1, 17, 33 and 49, Seifert discloses a method for extracting data from data store comprising a first set of one or more data items, the method comprising, the steps of: creating a selected set comprising a second set, of one or more data items in accordance with a selection rule (paragraph 62, wherein the search criteria are considered to form a set according to the selection rule); creating a profile of the data store (paragraph 58, wherein profile describes resources, and set of those descriptive terms form a set), the

profile comprising a profile rule defining a profile set (wherein the rule is the level of descriptiveness), wherein the profile set comprises a third set of one or more data items in accordance with the profile rule (i.e. placing words in the set that best describe a repository); responsive to a determination that an intersection of the selected set and the profile set is non-empty, extracting a fourth set of one or more data items from the data store in accordance with the selection rule (paragraph 53, i.e. relevant results); and responsive to a determination that an intersection of the selected set and the profile set is empty, providing an indication that the data store does not include data items in the selected set (if there is no intersection, there is no match to the searching criteria (set established based in the selection rule)).

Final office action of March 7, 2007 (pp. 2-3) (emphasis in original). The present form of claim 1 is as follows:

1. A method for extracting data from a data store comprising a first set of one or more data items, the method comprising the steps of:
 - creating a selected set comprising a second set of one or more data items in accordance with a selection rule;
 - creating a profile of the data store, the profile comprising a profile rule defining a profile set, wherein the profile set comprises a third set of one or more data items in accordance with the profile rule;
 - responsive to a determination that an intersection of the selected set and the profile set is non-empty, extracting a fourth set of one or more data items from the data store in accordance with the selection rule; and
 - responsive to a determination that the intersection of the selected set and the profile set is empty, providing an indication that the data store does not include data items in the selected set.

The rejection is clearly in error because *Seifert* does not teach the feature of, “creating a profile of the data store, the profile comprising a profile rule defining a profile set, wherein the profile set comprises a third set of one or more data items in accordance with the profile rule,” as in claim 1. *Seifert* also does not teach the feature of, “responsive to a determination that the intersection of the selected set and the profile set is empty, providing an indication that the data store does not include data items in the selected set,” as in claim 1.

Appellants first address the creating step. The Examiner asserts that *Seifert* teaches this claimed step in the following portion of *Seifert*:

[0058] At present, for ease of explanation, the RESOURCES can be viewed as computer files. However, as will be seen shortly, the RESOURCES actually include a vastly larger, and more diverse, collection of objects than mere computer files. RESOURCES include (a) data, (b) information, and (c) knowledge, both as these terms are generally defined, and also as defined by computer scientists. This data, information, and knowledge can take the form of computer-downloadable data, or other forms, such as printed matter. Each RESOURCE has an associated PROFILE, which contains descriptive information about the RESOURCE. FIG. 48 illustrates an exemplary

PROFILE. The user of a PC uses the PROFILES to locate RESOURCES of interest by searching through the PROFILES.

Seifert, paragraph 0058.

Generally, *Seifert* teaches containing a descriptive profile for each resource in a data processing system, allowing users to search all profiles and to search the profiles according to fields of a database, such as by location of the resources or by category of the resources. *Seifert*, Abstract. The user can order delivery of a selected resource, and the system causes delivery of the resource to be executed irrespective of the form of the resource. *Seifert*, Abstract. A provider of a new resource can limit access to the new resource by identifying users who are authorized to obtain access to the resource. *Seifert*, Abstract.

The particular portion of *Seifert* cited by the Examiner teaches that resources can be data, information, and knowledge in the form of computer-downloadable data or printed matter. Each resource has an associated profile which contains descriptive information about the resource. *Seifert* also cites Figure 48, which appears to be a screen shot. However, that figure is indecipherably garbled in any copy obtainable by Appellants.

The cited portion of *Seifert* does not teach the claimed feature of, “creating a profile of the data store, the profile comprising a *profile rule* defining a *profile set*, wherein the profile set comprises a third set of one or more data items in accordance with the profile rule,” as in claim 1. The Examiner asserts that “the rule is the level of descriptiveness.” However, this assertion is in error. *Seifert* does not describe a “level of descriptiveness” of a profile anywhere or in any form. *Seifert* only mentions the term “descriptiveness” or “description” five times total, and in each case only briefly. In the cited portion *Seifert* only states that the profile contains descriptive information. Later, *Seifert* states that:

[0114] Every RESOURCE carries with it a PROFILE. Each PROFILE contains important information about the RESOURCE, such as a description of the RESOURCE, where it is located, etc. The LOCATE AND VIEW option allows a user to view the PROFILES.

Seifert, paragraph 0114.

Seifert only states that a description of the resource is provided. In paragraph 0059, *Seifert* states that the description is a title. Contrary to the Examiner’s statement, *Seifert* provides no “level of descriptiveness.”

Additionally, even if *Seifert* did teach a “level of descriptiveness,” which it does not, this feature is not equivalent to a “profile rule,” as claimed and is not equivalent to a “profile set,” as claimed. A description is not a rule. *Seifert*’s description does not describe a “profile set,” which is a term well-defined in the specification and understood by those of ordinary skill in the art.

Therefore, *Seifert* does not teach the claimed feature of, “creating a profile of the data store, the profile comprising a *profile rule* defining a *profile set*, wherein the profile set comprises a third set of one or more data items in accordance with the profile rule,” as in claim 1. Accordingly, *Seifert* does not anticipate claim 1.

Additionally, *Seifert* also does not teach the feature of, “responsive to a determination that the intersection of the selected set and the profile set is empty, providing an indication that the data store does not include data items in the selected set,” as in claim 1. The Examiner asserts otherwise, stating that, “if there is no intersection, there is no match to the searching criteria.” However, this statement is also in error and has no basis in *Seifert*.

As described above with respect to the objection, the term “empty” does not mean that no intersection exists. The intersection exists, even if empty. In the claimed case, the fact that the set is empty prompts the claimed response. *Seifert* does not provide any indication that if the set is *empty* to take the *action of providing an indication*, in the manner provided in claim 1. *Seifert* simply is devoid of disclosure in this regard. Therefore, *Seifert* does not anticipate claim 1.

The rejections of the remaining claims all rely on the Examiner’s erroneous assertions regarding claim 1. Therefore, all of the rejections are clearly in error and should be withdrawn.

III. Conclusion

The Pre-Appeal Brief Conference Panel is invited to call the undersigned at the below-listed telephone number if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 7, 2007

Respectfully submitted,

/Theodore D. Fay III/ T.D.F.

Theodore D. Fay III
Reg. No. 48,504
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Appellants